

Ser. No. 10/823,719

UEHARA et al.

Attorney Docket No. S-2490/CONT/CIP

REMARKS

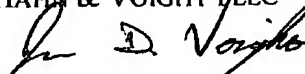
Claims 1-11 are pending. Claim 5 finds support throughout the specification which mentions top coat paints for motor vehicles. Claims 6-8 find support in original claims 2-4. Claim 9 finds support at page 2, lines 10-11, of the specification. Claim 10 finds support at page 3, lines 9-10.

The Examiner, citing 37 CFR 1.111, argues that it is impermissible to shift invention from product claims to method claim after the Office has acted on product claims. Applicants urge, however, that 37 CFR 1.111 does not prohibit such a shift, and that there is no *per se* rule against entering process claims in an application containing product claims. Applicants request the Examiner further define the basis for any refusal to examine the claims as presented.

In any event, applicants have added claims 5-11 which are directed to a product. It is noted that the product of claim 5 comprises the product of original claim 1, and therefore claim 5 contains all of the limitations of original claim 1, and is not mutually exclusive thereof (*see generally* MPEP 806.04(f)).

Favorable action with an early allowance of the claims pending is earnestly solicited.

Respectfully submitted,
HAHN & VOIGHT PLLC



Jason D. Voight
Reg. No. 42,205